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09/818,882	03/27/2001	Harry A. Reimer	S01.010	2429

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EXAMINER

MARKS, CHRISTINA M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,882

Applicant(s)

REIMER, HARRY A.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-12, 19-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetris Attack.

Regarding claims 1, 19 and 24, Tetris Attack discloses a method for facilitating game play wherein a game board is displayed to a player that has a plurality of game icons (Tetris Attack, How to Play from tetrisattack.net). The player can make a series of game moves (Tetris Attack, How to Play from tetrisattack.net). The player can input moves (Tetris Attack, How to Play from tetrisattack.net) and if at least three icons are lined up in the predetermined manner the game will remove at least one game icon from the game board (Tetris Attack, How to Play from tetrisattack.net). It would be obvious to a skilled artisan to use other restrictions in regulating how pieces are removed, as such restrictions are notoriously well known in the art. The manner in which the designer chooses to instate restrictions on removing pieces is a design choice made obvious by the state of the art. Motivation in using one rule over the other depends on a specific desire and need for the designer as to how they wish their game to flow. The game board can be reconfigured according to a plurality of reconfiguration game rules (Tetris Attack, How to Play from tetrisattack.net) wherein the pieces will rise from the bottom as well as fall from the top. The reconfiguration that is to occur in the game is not indicated to the player during the at least a portion of the game as the player does not initially see on the gaming screen that the blocks will fall or know the predetermined time in which they will rise. Regarding claim 19, the method of Tetris Attack is for the Super NES therefore when incorporated in the game system; it would have a processor as well as a storage device for

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storing the operation for execution. Regarding claim 22, it would be obvious to one of ordinary skill in the art that to properly execute the method on the Super NES as disclosed, it would need to be stored on a medium that embodied the instructions for the game.

Regarding claim 2, Tetris Attack indicates to the player the reconfiguration rule to be applied during a predetermined number of subsequent moves in that once play begins they will know that the blocks will fall until a predetermined time when the second reconfiguration rule will be applied and the blocks will then rise.

Regarding claim 3, these reconfiguration rules comprise the directions in which the icons will move (either falling or rising).

Regarding claim 4, each of the game icons are associated with icon types and the removal is based upon the icon type (Tetris Attack, How to Play from tetrisattack.net).

Regarding claim 5, the play input comprises the selection of at least one game icon and after an operation, removing neighboring icons based on associated icon types (Tetris Attack, How to Play from tetrisattack.net).

Regarding claim 6, a score is associated with the game (Tetris Attack Manual). It would be obvious to the game and one of ordinary skill in the art that the score would be based on the number of neighboring icons removed, as it would be known that removing a greater number would require more skill and thus would be awarded more points.

Regarding claim 7, the system determines which reconfiguration rule is applied to reconfigure the game board (Tetris Attack, How to Play from tetrisattack.net).

Regarding claim 8, this reconfiguration is determined by retrieving pre-stored indication of the rules (i.e. if the blocks are falling or if an indicator is set to indicate the blocks should rise).

Regarding claim 9, the reconfiguration rule is associated with the particular game, but can also be associated with a plurality of players as it is also disclosed that a third

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reconfiguration rule can be applied among a plurality of players wherein blocks may be dumped from the top of the screen.

Regarding claims 10 and 11, the method is disclosed for home play; however, it is notoriously well known in the art that games can be embodied in an arcade format wherein players could be charged money in exchange for game play and the implementation of Tetris Attack into this format would be obvious to one of ordinary skill in the art as well as using any of the well known payment methods to accomplish this incorporation.

Regarding claim 12, Tetris Attack discloses a series of moves is used in determining a game result (Tetris Attack, How to Play from tetrisattack.net and Tetris Attack Manual).

Regarding claim 20, when the implementation of the method occurs on a game system, the rules defining play, including the game database as well as rules associated with the rules of reconfiguration are inherently stored with the program controlling the game on the storage medium.

Regarding claim 21, the game system in the Super NES system is adapted to include a communication device coupled to the processor, such as a remote player device in the form of an input device, in order for the game to be properly executed and to receive the needed input from the player.

Regarding claim 25, the reconfiguration rules include dictating the reconfiguration direction.

Regarding claim 26, the game display comprises text information, image information, audio information, landscape information as well as other graphic and textual information (Tetris Attack, How to Play from tetrisattack.net and Tetris Attack Manual).

Regarding claim 27, Tetris Attack is a game of skill as well as a puzzle game (Tetris Attack, How to Play from tetrisattack.net and Tetris Attack Manual).

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Claims 13-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetris Attack in view of Uproar.

What Tetris Attack discloses, teaches and/or suggests has been discussed above and is incorporated herein.

Tetris Attack is a game of skill and discloses awarding the player points based upon their performance. As discussed above, it is notoriously well known in the art that any game can be embodied in an arcade format wherein players could be charged money in exchange for game play and the implementation of Tetris Attack into this format would be obvious to one of ordinary skill in the art. Further, in application of Tetris Attack to the arcade format, it is also notoriously well known that arcades often award players prizes in the alternate currency form of free games if their performance in the game results in attaining a certain threshold.

Further, Uproar.com discloses a gaming system wherein a plurality of games of skill that were popular as other forms are hosted in an online environment. Uproar allows players to set up accounts and receive points (alternate currency) for their performance (Uproar WebPage). Uproar also discloses that cash prizes are available (Uproar Handout). It would have been obvious to one of ordinary skill in the art to incorporate prizes into the disclosure of Tetris Attack in both the forms as disclosed above. By incorporating this methodology into the game of Tetris Attack wherein points or free games would be awarded, players would be more likely to continue to play the game, thus generating a revenue for the host (in the form of monetary or advertisement). Therefore, one of ordinary skill in the art would be motivated to incorporate prizes into the game disclosure of Tetris Attack in order to provide a more rewarding experience for the player.

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Claims 16-18 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetris Attack in view of msn games (Web Archive: MSN Games, 2000).

What Tetris Attack discloses, teaches, and/or suggests has been discussed above and is incorporated herein.

Tetris Attack discloses the use of a home game console to implement the gaming method. Tetris Attack does not disclose that the game is embodied on a game server.

msn games discloses a website wherein the games are hosted remotely from the player and the player can access the games from a remote location in order to operate them. The network of msn includes receiving the player input from a remote device via a communications network wherein the player device is a personal computer or other device able to access the site and the communications network comprises the Internet or other networks that allow the device to access the site.

It would have been obvious to one of ordinary skill in the art to incorporate the method of Tetris Attack into a game that is available on a website as disclosed by msn games. It is known to one of ordinary skill in the art that any game methodology can be programmed in a manner to distribute it over a communications medium. One of ordinary skill in the art would be motivated to make this incorporation to Tetris Attack in order to more widely allow the game to be distributed, while at the same time allowing the player to be able to compete against the scores of others; therefore, increasing the user access to the game, as well as creating a greater enjoyment among users as they will be able to see how they stack up against others.

Regarding claim 28, when a player device has performed an action requiring a reconfiguration rule, Tetris Attack receives an indication from the game controller of a first rule to be applied during the game without receiving an indication of the second game rule to be applied. Indication of the second rule is received only upon the criteria being met for the second

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rule to be applied (Tetris Attack, How to Play from tetrisattack.net and Tetris Attack Manual).

When the player performs the game tasks or upon exposure to the game, the first game rule to be applied is displayed in its application. As disclosed above, Tetris Attack does not explicitly disclose that the game controller is remote; however, it is notoriously well known in the art and shown by msn games that such puzzle games can be hosted remotely and accessed by a player. Therefore, if desired, one of ordinary skill in the art would readily understand that a remote controller could be in charge of the controls as disclosed for the game.

Regarding claim 29, the game receives input from the player at a player input and arranges the game board to be reconfigured based on the first rule wherein the game board has a plurality of icons that may be removed.

Response to Arguments

Regarding Applicant's confusion regarding the date of the reference, the Examiner supplies that the date of August 25, 2003 was merely the date the reference was printed out as is shown by the date of the Office action. However, as is evident from the disclosure of the reference, the three versions of Tetris Attack are dated in 1995, 1996 and 2000 and therefore all precede the Applicant's filing date of March 27, 2001. Further, to clarify for the Applicant, the Examiner has attached the game data sheets from ign.com that illustrate the release date of the two later games. The Examiner understands the burden to establish a reference as prior art. Regardless that the Examiner's reference originally listed dates for the games, the Examiner hopes to help the Applicant by providing the data sheets in addition. Thus the dating of the reference is established as required. The Examiner therefore believes she has fulfilled the request for clarification and the dates associated with the reference are clear, as well as what the reference discloses related to the three versions of the game.

Regarding Applicant's argument that the invention is distinct over the disclosure of Tetris Attack as a game piece is removed each time, the Examiner respectfully disagrees. The Examiner maintains that a game icon is removed based on the player input. Tetris merely adds a secondary rule structure that requires three pieces to be in a row. This does not serve to negate the essential teachings of Tetris Attack. It would be obvious and understood by a skilled artisan that the means in which the player can remove icons is non-essential to the teachings of the reference. Adding a limitation to the sort would not detract from the teachings. Further, the concept of allowing a player to only input in ways that would remove a game icon are known in the art and have indeed been previously cited by the Examiner. It would be obvious to a skilled artisan to use other restrictions in regulating how pieces are removed, as such restrictions are notoriously well known in the art. The application of such does not represent an inventive step as so many rules are known in the art and the choice among them would be merely that of design. The manner in which the designer chooses to instate restrictions on removing pieces is a design choice made obvious by the state of the art. Motivation in using one rule over the other depends on a specific desire and need for the designer as to how they wish their game to flow.

Regarding Applicant's argument that Tetris Attack does not reconfigure the game board according to one of a plurality of reconfiguration rules, the Examiner respectfully disagrees. The pluralities of rules are associated with the dropping of a piece wherein pieces will rise from the bottom as well as fall from the top. The Applicant does not know which will occur and the game can select when to move the pieces up as well as when they are dropped. The rules are applied during a game move and are not indicated to the player. The pieces may be dropped on a player or the pieces may rise from the bottom depending on the current situation, which dictates which one of the pluralities of reconfiguration rules should be used.

Regarding Applicant's argument that Tetris Attack does not hide the reconfiguration rules from the players, the Examiner respectfully disagrees. The Examiner maintains that the reconfiguration rule is associated with timing and when it is applied is what is not indicated to the player, and the timing is explicitly part of the rule. Along the Applicant's line of reasoning, they believe that a player could access an instruction book and therefore know the rules. The Examiner maintains the same argument could be applied to the Applicant's game. The Applicant discloses a number of specific rule types associated with their game. If a player using the Applicant's game had access to an instruction manual in the same means the Applicant asserts against Tetris, the player would also be informed of the type of rules that could be moved. The player would thus know the shift can occur to the left, right, up, or down, and even after playing the game for the first time, they would understand the rules to be applied. However, like the Applicant's game, a non-informed Tetris player would be total unaware of the reconfiguration rules that could be applied against them. Arguing about the apparent and supposed knowledge of a specific player does not convince the Examiner that as a whole the reconfiguration rules are not hidden. Regardless, even though the player may "know" of the types of reconfiguration rules that may be applied against them, the actual rule is not indicated to the player in association with the game, as they will not know which of the rules will be chosen then. Even though they know a plurality of rules are available, it remains non-disclosed, as the player is not aware of when the rule will actually be applied and is thus not indicated to the player.

Regarding Applicant's argument about the game controller, the Examiner respectfully disagrees. The Applicant seems to be ignoring the fact that the game is a software program that axiomatically must work with hardware in order for a result to be produced. The incorporation of hardware with software to produce a game is a fact of the art. The software

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must work with the hardware to accomplish the game functionality. Though the software documentation provided does not detail this, a skilled artisan understands the communication with the controller in association with the software actions cited. Documents often omit that which is known and this is the apparent case in the software disclosure of the games as details encasing the interaction of the hardware are not present; however, this does not detract from the knowledge of a skilled artisan which dictates that this must be so in order for proper operation. Further, at the Applicant's request the Examiner clarifies action requiring a reconfiguration rule to apply in one instance relating to the timing of the pieces moving.

Regarding the Applicant's argument that in the rejection of many of the dependent claims the Examiner improperly relies upon her own factual assertions, the Examiner respectfully disagrees. The argument is conclusionary as the Applicant is merely asserting the Examiner is incorrect and provides no reasoning or support as to why. Therefore, such an argument is not convincing as it is merely an assertion of opinion and does not provide concrete examples or facts as to where the deficiency exists.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner provided proper motivation statements with each rejection. Further, the Applicant's argument regarding what their specification teaches and why they made the combination is not in of itself convincing as such arguments do not serve to

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negate other reasons for combination and further is not coterminous with the claim language as it goes beyond what is actually claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cmm

April 14, 2004



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